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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,737	11/01/2000	Lester F. Ludwig	VCOR-001/20US	3630

7590

02/08/2002

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EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 02/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NM.

Office Action Summary

Application No.

09/702,737

Applicant(s)

LUDWIG ET AL.

Examiner

Dung Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - Double Patenting

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,854,893 in view of Marshak "BeyondMail for Windows". Although the conflicting claims are not identical, they are not patentably distinct from each other because they claimed essentially similar limitation. The patent does not claims a first directory viewable by all participants and a second directory being a subset of the first directory viewable by a single participant. Marshak discloses that it is known in the art to

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provide global and private directories (address books - see page 4 "Managing address book"). Hence, It would have been obvious for one of ordinary skill in the art to provide a private second directory which is a subset of the global directory because it would have enable the user to more efficient grouping and identification of the participants.

Claims 21-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,237,025 in view of Marshak "BeyondMail for Windows". Although the conflicting claims are not identical, they are not patentably distinct from each other for the same reason stated for Patent 5,854,893 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al. US patent 5,195,086 and further in view of Marshak "BeyondMail for Windows" and Rangan et al. "Software Architecture for Integration of Video Services in the Etherphone System".

As per claim 21, Baumgartner teaches a teleconferencing essentially as claimed, comprising:

a plurality of video display [inherent in fig.1 workstation A, B, & C]; having audio capture and reproduction capabilities [col.15 lines 5-15];

at least a communication path [fig.1];

wherein the system is configured to display a directory [fig.18]; and

to initiate collaboration upon selecting one or more participants from the display and establish communication with each selected participant [col.18 lines 51 col. 19 lines 13].

Baumgartner does not specifically disclose first and second directory in which the second directory is a subset of the first directory. Marshak discloses that it is known in the art to provide global and private directories (address books - see page 4 "Managing address book"). Hence, It would have been obvious for one of ordinary skill in the art to provide a private second directory which is a subset of the global directory because it

would have enable the user to more efficient grouping and identification of the participants.

Baumgartner does not specifically disclose usage of video or video capture capabilities. Rangan teaches a system for video/audio conferencing with video capture capabilities. It would have been obvious for one of ordinary skill in the art to have video with Baumgartner system because it would have enhanced the collaborative interactions among the users. As per claim 22, Baumgartner teaches using icon representing the participants [fig.18].

As per claim 22, Baumgartner teaches using icon and text [see fig.19].

AS per claim 23, Rangan teaches selecting communication types [p.1397 col.2]. Baumgartner teaches using GUI for selecting participant and collaboration applications. Hence, it is apparent the system as modified would have GUI means for selecting the communication type. It would have been obvious for one of ordinary skill in the art to enable the participant to select the conferencing type because it would enable efficient and flexible use of the conferencing system.

As per claim 24, the communication types provided would have been a matter of design choice because it is dependent upon the capabilities of the conferencing system at hand. The method of

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providing iconic participants directory method would operate essentially the same way regardless of what communication types is available. One of ordinary skill in the art would have known to provide means for the participant to select any communication type available in the system so as to enable the participants to make full use of the conferencing services.

As per claim 25, Baumgartner teaches graphic user interface for selecting the participants.

As per claim 26, Baumgartner teaches a default collaboration type upon selecting of a participant [col.19 lines 21-22 'phone'].

As per claim 27, Baumgartner teaches adding new participant [col.22 lines 56+]

As per claim 28, Rangan teaches reproducing audio/video for another participant [p. 1402 col.2 "video document"].

As per claim 29, The references does not specifically disclose hot key for selecting a participant. It is well known in the art to provide hot key for quick access too menu and other application functions. Hence, it would have been obvious for one of ordinary skill in the art to provide a hot key to select a participant because it would have enable to use to have quick, convenient access to the directory

Claims 30-41 are rejected under similar rationales as for claims 21-29 above.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (703) 305-4792.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2100 Customer Service whose telephone number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)
(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



Dung Dinh
Primary Examiner
February 5, 2002